

REMARKS:

The claims in the application remain 1-16 and 18- 20.

Favorable reconsideration of the application as amended is respectfully requested.

Independent Claim 1 has been amended to eliminate the rejection under 35 U.S.C. §112, second paragraph, raised in paragraphs 3 and 4 on page 2 of the Office Action.

Claims 1-15 have been rejected under 35 U.S.C. §103 as obvious over GB 2,291,578 to McNamee et al in view of U.S. Pat. No. 4,670,271 to Pasternak in paragraphs 2-14 on pages 3-5 of the Office Action while Claim 18 has been rejected additionally in view of U.S. Pat. Pub. No. 2004/0040446 to Errera in paragraphs 15-20 on pages 6-7 of the Office Action. In this regard, Claims 16, 19 and 20 have not been rejected over art. Accordingly, it is respectfully submitted Claims 16, 19 and 20 should now be in condition for allowance because the rejection under 35 U.S.C. §112, second paragraph, has been eliminated; alternatively, any future prior art rejection of Claims 16, 19 and 20 must be made in a non-final Office Action.

In any event, it is respectfully submitted the invention as recited in all pending claims herein is patentable over this combination of art, for the following reasons.

McNamee et al disclose a method for applying an edible marking substance to a portion of the surface of a product prior to baking. The edible marking substance is in liquid form and comprises sugar, starch or protein, or mixtures thereof, in an aqueous or organic medium which is preferably ethanol. In

paragraphs 1.a. and 3.a. on pages 7-8 of the Office Action, it is asserted McNamee et al *implicitly* recognizes surface tension problem where the marking material might bead on contact with the product and the marking material should therefore possess low surface tension to avoid this problem. Thus, it is apparently contended lowering surface tension is the natural reason for choosing ethanol or water as medium for the marking material.

However, several factors must be considered when selecting medium for a marking material for dough to be baked. Firstly, the medium must be non-toxic and edible (i.e., not foul-tasting). Secondly, the medium ideally is inexpensive and readily-available. Both these factors might indeed lead one skilled in the art to choose ethanol or water as medium for the marking material. However, while these media might indeed possess low surface tension, nevertheless there is no suggestion or implication in McNamee et al choosing such media is based upon any considerations other than choice of simple, non-toxic and readily-available liquid.

Therefore, at most, it is only with benefit of hindsight after studying the present application, one skilled in the art might choose either ethanol or water as marking material liquid to produce a clear, marked image, due to low surface tension. Furthermore, it is asserted in paragraphs 2.a. and 3.a on pages 7-8 of the Office Action one skilled in the art, having allegedly determined from McNamee et al a low surface tension ink is required, would then turn to Pasternak for the ink composition itself.

However, there is no disclosure or suggestion in Pasternak (1) the inks

disclosed therein possess low surface tension or (2) this would even constitute an advantage of applying such inks to dough before baking. The ink of Pasternak is not applied to a dough product, but rather to cake icing, chocolate or confectionary products. These products are much higher in sugar and/or fat content compared to bread dough, pastry or even biscuit dough and thus are likely to possess different surface properties. If anything, one skilled in the art would be aware the ink of Pasternak is likely to behave in a different manner in terms of beading when applied to a bakery product rather than a confectionary sheet, due to different surface properties.

Indeed, the inks of Pasternak are often transferred to the product by applying pressure to a transfer sheet covered with the ink in dried form. Clearly, surface tension is not a consideration for the inks of Pasternak when in dried form.

It is furthermore asserted in paragraph 2.a. on pages 7-8 of the Office Action the ink composition of Pasternak "clearly overlaps" the ranges recited in pending Claim 1. However, this assertion is incorrect; Pasternak discloses a sucrose content of 1–5% (column 16, line 44 and Claim 8) while Claim 1 recites a sucrose content of 6-60%. Moreover, Pasternak discloses less than 1% food coloring (column 16, line 47 and Claim 8) while Claim 1 requires 1-20% coloring agent.

To summarize, there is no recognition in either McNamee et al or Pasternak an ink composition which beads on contact with a bakery product will result in a blurry image, or even an ink with low surface tension will avoid this problem. Thus, there is no motivation for a person skilled in the art, when presented with McNamee et al, to utilize the ink of Pasternak to solve the problem of a blurry

image. Additionally, even if such a person skilled in the art were to combine the method of McNamee et al with the ink of Pasternak, such an individual would still not arrive at the claimed invention.

In support of patentability of the claimed invention, a Declaration under 37 C.F.R. §1.132 executed by the inventor Clinton Scott Waldock, is enclosed. Paragraphs 3-7 of the enclosed Declaration describe Mr. Waldock arriving at the presently-claimed invention. In paragraph 9 of his Declaration, Mr. Waldock states McNamee et al fail to recognize problem of printing or marking clarity and even disclose unsatisfactory blurring upon marking. Mr. Waldock makes further observations concerning deficiency of teaching in McNamee et al in paragraph 10 of his Declaration and points out, in paragraph 13 of his Declaration, Pasternak teaches applying ink at room temperature only, quite different from consideration in marking dough that is subsequently baked.

Accordingly, different considerations and purposes are involved with the inks of Pasternak from the marking inks on bakery dough (paragraphs 12 and 14 of Mr. Waldock's Declaration). Furthermore, it is noted by Mr. Waldock in paragraph 15 of his Declaration Pasternak appears to require propylene glycol, a high surface tension liquid, as an essential component. Therefore, Mr. Waldock concludes, in paragraph 17 of his Declaration, even should McNamee et al and Pasternak be considered together, substantial, unobvious modification of the ink would still be required to arrive at the presently-claimed invention.

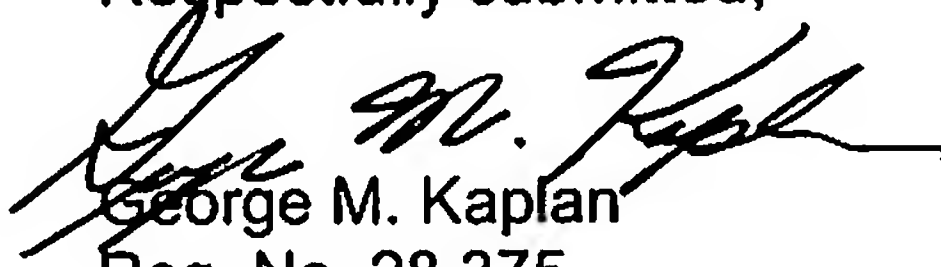
Errera adds nothing to McNamee et al and/or Pasternak which would render obvious the invention recited in Claim 18 while the remaining art has not been

applied against the claims and will not be commented upon further at this time.

Therefore, in view of the forgoing amendment, accompanying remarks and enclosed Declaration under 37 C.F.R. §1.132, it is respectfully submitted all claims pending herein are in condition for allowance. Please contact the undersigned attorney should there be any questions.

Early favorable action is earnestly solicited.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "G. M. Kaplan", is written over the printed name.

George M. Kaplan

Reg. No. 28,375

Attorney for Applicant(s)

DILWORTH & BARRESE, LLP
1000 Woodbury Road, Suite 405
Woodbury, New York 11797
Telephone: (516) 228-8484
Facsimile: (516) 228-8516